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AP \$ 200

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
AARL 00-31 03

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Application Number
09/910,669Filed
7/20/2001First Named Inventor
Gregory S. Francis et al.Art Unit
2173Examiner
Ting Zhou

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record.

Registration number 46,075

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Registration number if acting under 37 CFR 1.34. _____

June 14, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

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forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Gregory S. FRANCIS, et al. Confirmation No.: 3153
Serial No. : 09/910,669 Examiner: ZHOU, TING
Filed : July 20, 2001 Group Art Unit: 2654
For : MULTIFUNCTION DISPLAY DESIGN TOOL

REQUEST FOR PRE-APPEAL CONFERENCE & BRIEF

Commissioner for Patents
Box 1450
Alexandria, VA 22313-1450

Sir:

For the reasons set forth below, Applicant requests that the final rejection of claims 1-8, 10-17 and 19-26 be reviewed by an appropriate panel pursuant to the USPTO's Pre-Appeal Conference procedures and, as a result, the rejection of claims 1-8, 10-17 and 19-26 be overturned.

SUMMARY OF THE ARGUMENTS

Claims 1-5, 8, 10-14, 17, 19-23 and 26

Claims 1-5, 8, 10-14, 17, 19-23 and 26 stand finally rejected under 35 U.S.C. §103 as being allegedly unpatentable over Wagner et al. (USP 6,002,395) in view of Shirayanagi (USPA 2001/0050752).

Applicant respectfully submits that the asserted rejection of claims 1-5, 8, 10-14, 17, 19-23 and 26 under 35 U.S.C. §103 over Wagner and Shirayanagi, is clearly erroneous at least because, as described in detail below, 1) the grounds of rejection provided in the Final Office Action dated March 29, 2006, fail to provide with particularity the motivational basis for one of ordinary skill in the art to combine the references in the manner proposed, and, 2) without the knowledge obtained from the present application a skilled artisan would not have been motivated to combine the independent teachings of Shirayanagi and Wagner.

Claims 6, 7, 15, 16, 24 and 25

Claims 6, 7, 15, 16, 24 and 25 stand finally rejected under 35 U.S.C. § 103 as being allegedly unpatentable over Wagner et al. and Shirayanagi in further view of Ikemoto (USP 5,969,717).

Applicant respectfully submits that the asserted rejection of claims 6, 7, 15, 16, 24 and 25 under 35 U.S.C. §103 over Wagner et al., Shirayanagi in further view of Ikemoto, is clearly erroneous at least because, as described in detail below, 1) the grounds of rejection provided in the Final Office Action dated March 29, 2006, fail to provide with particularity the motivational basis for one of ordinary skill in the art to combine the references in the manner proposed, and 2) without the knowledge obtained from the present application, a skilled artisan would not have been motivated to combine the independent teachings of Shirayanagi, Wagner and Ikemoto.

DETAILED ARGUMENTS

Claims 1-5, 8, 10-14, 17, 19-23 and 26

It is asserted in the Final Office Action dated March 29, 2006, that claims 1-5, 8, 10-14, 17, 19-23 and 26 are unpatentable over Wagner et al. in view of Shirayanagi. Specifically, it is asserted that it would have been obvious to one of ordinary skill in the art to modify the method of building a graphical user interface (GUI), as allegedly taught by Wagner, to include the use of constraint cost values for optimization, as allegedly taught by Shirayanagi. It is further asserted that "one would have been motivated to make such a combination in order to allow easy and fast optimization of parameters, reducing cost of labor and preserving design repeatability." (Final Office Action, p. 5).

This is an insufficient basis under 35 U.S.C. § 103 to render the claimed invention obvious because it embraces classic hindsight reconstruction and contravenes well established principles of obviousness. More particularly, a *prima facie* case of obviousness has not been set forth because it has not been established with particularity why a skilled artisan would be motivated to combine the references in the manner proposed.

For a *prima facie* case of obviousness to exist, there must be "some objective teaching in the prior art or ... knowledge generally available to one of ordinary skill in the art [that] would lead that individual to combine the relevant teachings of the references." *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). "The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved." *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000).

Here, the grounds of rejection assert, axiomatically, that one of skill in the art would have been motivated to combine the independent teachings of Wagner and Shirayanagi to

achieve the claimed invention, "in order to allow easy and fast optimization of parameters, reducing cost of labor and preserving design repeatability." These reasons, however, have been set forth for the sole purpose of showing motivation and are void of any supporting citations to relevant portions of Wagner, Shirayanagi, or any other authority. The basis for finding motivation to combine the cited references amounts to no more than conclusory statements of generalized advantages and convenient assumptions about skilled artisans. Such conclusory findings clearly do not satisfy the "motivation to combine" requirement attendant to a rejection under 35 U.S.C. § 103. See, e.g., *In re Zweiman*, 25 Fed. Appx. 937, 939 (Fed. Cir. 2001); *In re Beasley*, 117 Fed. Appx. 739, 744 (Fed. Cir. 2004). Further, no "official notice" has been asserted in this case. The fact is, nowhere in the record, other than in Applicant's specification, is the notion of using constraint costs and their associated values disclosed for the purpose of efficiently assigning labels to displayed buttons, as claimed.

Accordingly, the Examiner in this case has engaged in classic hindsight reconstruction. No *prima facie* case of obviousness has been established for the rejection of any of claims 1-5, 8, 10-14, 17, 19-23 and 26 and the 103 rejection of these claims should be overturned.

Claims 6, 7, 15, 16, 24 and 25

Claims 6, 7, 15, 16, 24 and 25 are believed to be patentable over the art of record at least for the reasons set forth above with respect to independent claims 1, 10 and 19. Additionally, however, the final rejection of these dependent claims should be overturned for the reason that follows.

In particular, it is asserted in the Final Office Action dated March 29, 2006, that claims 6, 15 and 24 are unpatentable over Wagner et al. in view of Shirayanagi and Ikemoto. It is asserted that it would have been obvious to one of ordinary skill in the art to modify the GUI building method, as allegedly taught by the proposed combination of Wagner and Shirayanagi, "to include the use of distance related metrics to define relationships between GUI components," as allegedly taught by Ikemoto. The basis provided by the Examiner for why one of skill would have been motivated to combine the references in this manner was;

One would have been motivated to make such a combination in order to create an efficient interactive process between the user and the GUI builder program; by allowing the users to specify [sic] exactly the distance

between each and every component on the display screen, users will be able to create an interface customized to their preferences and needs. (Final Office Action, p. 7).

Similar to the argument presented above in regard to claims 1-5, 8, 10-14, 17, 19-23 and 26, however, this is an insufficient basis under 35 U.S.C. § 103 to render the claimed invention obvious. Again, the Examiner has provided only conclusory statements about alleged benefits of the proposed combination of references, without citing to any source for these conclusions.

Lastly, it is asserted that claims 7, 16 and 25 are unpatentable over Wagner et al. in view of Shirayanagi and Ikemoto. Specifically, it is asserted that it would have been obvious to one of ordinary skill in the art to modify the GUI building method, as allegedly taught by the proposed combination of Wagner and Shirayanagi, "to include the use of constraint costs for the interaction of GUI components," as allegedly taught by Ikemoto. The basis provided by the Examiner for why one of skill would have been motivated to combine the references in this manner was;

One would have been motivated to make such a combination in order to create an efficient interactive process between the user and the GUI builder program; by allowing the users to specify [sic] exactly what factors and relationships are most important in placing components on the display screen, users will be able to create an interface customized to their preferences and needs. (Final Office Action, p. 8).

Yet again, similar to the arguments presented above, this is an insufficient basis under 35 U.S.C. § 103 to render the claimed invention obvious. With respect to claims 7, 16 and 25, the Examiner has again provided only conclusory statements about alleged benefits of the proposed combination of references. No official notice has been alleged and no reference to a source or sources from where the skilled artisan would have learned of the alleged benefits of combining the teachings of the references was provided.

For the above additional reasons, the rejection of claims 6, 7, 15, 16, 24 and 25 should be overturned for lack of a *prima facie* case of obviousness.

Non-Analogous Art

In addition to the arguments presented above, Applicant further submits that Shirayanagi is directed to non-analogous art and, thus, its application with respect to the rejection of any claims of the present application is erroneous. More particularly, Shirayanagi is directed to the field of designing and manufacturing spectacle lenses and,

thus, Shirayanagi is clearly not from the same field of endeavor as the present application, which is directed to a multi-function design tool for developing a graphical user interface (GUI).

Indeed, even though Shirayanagi is not from the same field of endeavor, it may still be analogous if it is "reasonably pertinent to the particular problem with which the inventor is involved." *In re Paulsen*, 30 F.3d 1475, 1481 (Fed. Cir. 1994). In this case, however, the disclosed method of designing and manufacturing spectacle lenses in Shirayanagi, even assuming *arguendo* that it utilizes "constraints" to assist in the automation process, is so far removed from the field of automating a GUI design, that it can not reasonably be said to be pertinent to the present inventor's problem. A skilled artisan with no knowledge of the present application simply would not have consulted the teachings of Shirayanagi to address the problem that was before the present inventor.

Conclusion

In view of the foregoing, as well as the remarks presented in at least the January 5, 2006 response, Applicant submits that the rejections asserted against claims 1-8, 10-17 and 19-26 are erroneous and that all of the pending claims of the present application are allowable. Accordingly, reconsideration of the rejections and favorable disposition of the present application are respectfully requested.

Respectfully submitted,
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